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1. I make this report based upon my knowledge or information as to the factual

2. I incorporate by reference my *curriculum vitae*, publications, and exhibits submitted

1. List of declarations and declarations filed in Ser. No. 09/315,796 (W012914

4. File wrapper of Serial No. 08/435,798 (W01348 - W02034)

3. It is hornbook law that "conception" of an inventor is the "formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice." 1 Robinson on Patents 532 (1890). As stated by the U.S. Court of Appeals for the Federal Circuit: "All that remains to be accomplished, in order to perfect the instrument or the act or instrument, belongs to the department of construction, not invention. It is therefore the formation, in the mind of the inventor of *a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice*, that constitutes an available conception, within the patent law." *Coleman v. Dines*, 754 F.2d 353, 359, 224 USPQ 857 (Fed. Cir. 1985) (emphasis the Federal Circuit), quoting *Gunter v. Stream*, 573 F.2d 77, 80, 197 USPQ 482, 484 (CCPA 1978). Conception exists when a definite and permanent idea of an operative invention, including every feature of the subject matter sought to be patented, is known. *Sewell v. Walters*, 21 F.3d 411, 415, 30 USPQ2d 1356 (Fed. Cir. 1994). Conception is complete when one of ordinary skill in the art could construct the apparatus without unduly extensive research or experimentation. *Id.* I have read the report of expert Jim Taylor who indicates that as of mid-June, 1994, and indeed as far back as early June 1992, Davis and Williamson were in possession of a complete concept of their claimed method of the '363 patent. Note paragraph 47, Expert Report of Jim Taylor, answers to questions (b), (e) and (f). Specifically, Mr. Taylor states that based on the information transmitted from Jesse Williamson and Bill Davis to PRI employee Baker on June 12, 1994, that one of ordinary skill in the art

"could have readily constructed a retractable printer/coater with an anilox roller and chambered doctor for interstation use in the summer or fall of 1994 without undue experimentation, and that the

information given to Baker was sufficient to instruct the average person skilled in the art what to do to arrive at a device to perform the flexographic/lithographic process of the '363 patent."

From the expert conclusions of Jim Taylor, I conclude that Williamson and Davis had transmitted a complete conception of their claimed invention as early as June 1994, and had in their possession a conception of the invention of the '363 patent as of that time.

4. Further, I have read the Declaration of Harry Bowyer executed September 9, 2000 bearing production numbers W013287-13311. Mr. Bowyer states that he visited Dallas in October 1992 and that Davis and Williamson, at that time, went over with him their concept of going "up front" with an anilox flexographic printer/coater and mentioned that same could be accomplished by a dedicated station, an auxiliary "rack-back" device, or a "T-head" device. Paragraph 4, Bowyer Declaration. Based upon that sworn testimony, it is clear that Williamson and Davis had a corroborated complete conception of their invention in October of 1992. According to the testimony of Davis and Williamson, they arrived at a complete concept of a workable invention, including the formation of several alternative types of devices to perform their method, when Williamson returned to the United States from Germany at the end of May 1992 or early June 1992. See Joint Declaration (1) Under 37 C.F.R. §1.131 and (2) Pertaining to Derivation by DeMoore and Printing Research, Inc. of Reissue Applicants' Invention, executed by Davis and Williamson on June 3, 2000, specifically at paragraph 4 (W012997, W012998) and Declaration of Jesse Speight Williamson, executed September 22, 2000, at paragraph 8 (W013263 at W013265). Oral testimony may be used to corroborate the testimony of an inventor for priority purposes, so long as it is appropriately scrutinized. *Jardine v. Long*, 19 CCPA 1243, 58 F.2d 836, 837, 13 USPQ 254 (CCPA 1932). The communication by Davis and Williamson to Harry Bowyer constituted a corroborated

conception of the '363 invention as of the date of the discussions with Bowyer in the United States.

5. Based on the Declarations of Baker and Brown concerning their communications with Davis and Williamson in the summer of 1994, I conclude that Davis' and Williamson's conception was corroborated by those 1994 communications. Declaration of Stephen Baker executed November 3, 1999 at paragraphs 4-9 (W013251 at W013254); Supplemental Declaration of Stephen Baker executed October 5, 2000, at paragraph 2 (W013256 at W013257); and, Declaration of Scott Brown executed December 30, 1999, at paragraph 2 (W013329 at W013330.)

6. According to the Rule 131 declaration mentioned in paragraph 4, and the testimony of each of Davis and Williamson in their respective depositions, Davis and Williamson had a discussion with Baker of PRI on **June 12, 1994** in which they asked Baker of PRI to consider constructing a retractable device for WPC to perform the Davis/Williamson method. An inventor "may use the services, and aid of others in the process of perfecting his invention without losing his right to a patent." *Shatterproof Glass Corporation v. Libby-Owens Ford Company*, 758 F.2d 613, 624, 225 USPQ 634 (Fed. Cir. 1985) citing *Hobbs v. U.S. Atomic Energy Commission*, 451 F.2d 849, 864, 171 USPQ 713 (5<sup>th</sup> Cir. 1971); see also, *Hess v. Advance Cardiovascular Systems, Inc.*, 106 F.3d 976, 980-981, 41 USPQ2d 1782, 1786 (Fed. Cir. 1997). Furthermore, Fig. 2 of the '363 patent, according to the expert report of Jim Taylor, was within the method concept of Davis and Williamson. See paragraph 47, Expert Report of Taylor. Williamson and Davis hired PRI to make an auxiliary, retractable interstation coater with an anilox roller and chambered doctor. Under the applicable law, Davis and Williamson had the right to have a vendor or contractor at arms length perform the construction of a device for use with their inventive method to reduce the invention to practice. Based on one of the landmark patent cases of the United States Supreme Court, an inventor

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may hire another to construct a device to perform his invention, and such hiring does not operate to create a joint invention because the intellectual property rights of the contractor belong to the true inventor. See *Agawam Company v. Jordan*, 74 U.S. (7 Wall.) 583, 19 L. Ed. 177(1868). Under the *Agawam* case, the cantilevered device technology, whether or not patentable, becomes the property of Davis and Williamson. According to expert Taylor, there were at least seven known techniques in 1994 of accomplishing the concept of the Davis and Williamson method. Nuances in the construction of an apparatus to perform the Davis/Williamson process do not change inventorship of the method or ownership rights with respect to the apparatus:

"... such suggested improvements are in general to be regarded as the property of the party who discovered the original principle, and may be embodied in his patent as part of his invention."

*Agawam*, 19 L. Ed at 182. See also, *Amax Fly Ash Corporation v. United States*, 206 Ct. Cl. 756, 514 F.2d 1041, 1050, 182 USPQ 210, 185 USPQ 437 (Ct. Cl. 1975); *Mueller Brass Co. v. Reade Industries*, 352 F.Supp. 1357, 1374, 176 USPQ 361 (E.D.P.A. 1972); *Rodgard Corporation v. Miner*, 914 F.Supp. 907, 917-918 (W.D. N.Y. 1995).

7. I have noticed in several of the depositions (specifically those of Davis and Williamson), questions on the part of counsel Harris as to the reasons why Davis and Williamson did not file a patent application until August of 1995. Davis and Williamson, having conceived their method in June of 1992, were under no duty to file a patent application or even reduce their method to practice on a hurried basis. They had not published their invention and, therefore, were not under the constraints of a 35 U.S.C. §102(b) bar. As a general rule, absent the running of the grace period after sale or publication of the invention, an inventor has no duty to file a patent application. *Bates*

v. *Coe*, 98 U.S. (8 Otto) 31, 46, 25 L.Ed. 68 (1878). Even in priority contests and after reduction to practice, delay in filing a patent application does not constitute an abandonment unless circumstances exist creating an inference of an intent to permanently abandon, suppress or conceal.

I am not aware of any evidence of an intent to abandon their invention indicated in Davis' and Williamson's declarations or their testimony in their depositions.<sup>1</sup> Hence, there could be no issue of abandonment of their invention due to their alleged "delay" in filing a patent application until August of 1995.

8. In reviewing both the Complaint filed May 20, 1999 and the First Amended Original Complaint filed on September 11, 2000, there are allegations on the part of Plaintiffs that Defendants derived their claimed method from PRI employees Steve Garner ("Garner") and John Bird ("Bird") in November of 1994. See paragraph 16, First Amended Original Complaint. Garner and Bird do not support such an allegation in either of their respective declarations or their deposition testimony. Neither Rendleman or DeMoore testified that they conveyed the substance of the '363 claimed methodology to Davis or Williamson or anyone in privity with Davis and Williamson at any time during 1994 or 1995. See DeMoore Depo. p.199, line 24 - p. 200, line 5. Rendleman testified he had not read the Amended Complaint. Rendleman Dep., p. 210, line 19. Derivation can be shown

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<sup>1</sup> Even had there been an interference with PRI based upon any hypothetical early conception of PRI, the testimony of Davis and Williamson show reduction to practice activity between the fall of 1994 and March 1995 when WPC was ordering presses, followed by experiments performed under Davis' and Williamson's directions in December 1994, and February and March 1995, and patent drafting beginning in January 1995. *Cochran v. Kresock*, 530 F.2d 385, 394, 188 USPQ 553 (CCPA 1976).

by a communication of a complete or partial concept to the party charged with derivation, with the burden of proof being on the party asserting derivation. *Hedgewick v. Akers*, 497 F.2d 905, 908, 182 USPQ 167 (CCPA 1974). I am not aware of any evidence that Davis and Williamson derived the '363 method from DeMoore and/or Rendleman. In fact, the evidence is to the contrary through the three declarations of Bird and the two declarations of Baker. Based on their testimony, Davis and Williamson communicated the method claim to Baker on Sunday, June 12, 1994 in Atlanta, Georgia. John Bird received that information from Baker, and then Bird alone or Bird and Baker transmitted it to DeMoore on the morning of June 15, 1994.

9. Concerning Plaintiffs' claim of inventorship in DeMoore, alone (Original Complaint of May 20, 1999) or of DeMoore and Rendleman jointly (in their First Amended Original Complaint), I am not aware of adequate proof of a conception on the part of DeMoore and/or Rendleman of the '363 method in the summer or fall of 1994. A party seeking to prove conception may not rely *solely* on the oral testimony of the alleged inventor because conception is a mental act. Some form or corroborating evidence - i.e., evidence in addition to the inventor's oral testimony - is required. *Burroughs Welcome Co. v. Barr Lab, Inc.*, 40 F.3d 1223, 1228, 32 USPQ2d 1915 (Fed. Cir. 1994); *Price v. Symsek*, 988 F.2d 1187, 1194 - 1996, 31 USPQ2d 1905 (Fed. Cir. 1993). If the alleged inventor's oral testimony is not corroborated, it cannot be credited. *AMP, Inc. v. Fujitsu Mircoelectronics, Inc.*, 853 F. Supp. 808, 821-822, 31 USPQ2d 1705 (N.D. Penn. 1994). DeMoore's claim of inventorship made in his original complaint and indicated in his deposition testimony as having been transmitted to his patent attorney on or about July 7, 1994, has not been corroborated, is suspect, and subject to great scrutiny. *Gianladis v. Kass*, 51 CCPA 753, 760; 324 F.2d 322, 327-8, 139 USPQ 300 (CCPA 1963). Such allegations of corroboration when no third parties are involved

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-- only employees of an adversary and their lawyer-- must be scrutinized with great particularity and care, especially six years after the event. *Schwartz v. Graeng*, 23 CCPA 883, 896; 81 F.2d 767, 776, 28 USPQ 386 (CCPA 1936). Rendleman, as an alleged co-inventor of the claimed method indicated in the First Amended Original Complaint, cannot corroborate his alleged joint method invention. The invoice of the attorney, Dennis Griggs, indicates that an "office conference" [i.e., at the office of Griggs] occurred with Howard DeMoore and John Bird on July 7, 1994. No other PRI employees are indicated as being present, contrary to Rendelman's and DeMoore's deposition testimony. Bird specifically repudiates in his supplemental declaration testimony and deposition testimony that the invention originated with DeMoore or anyone else at PRI including himself. The only remaining person at the meeting is the lawyer -- inherently suspect -- who has yet to testify. PRI executive, Garner indicated in his declaration, that he did not "recall seeing anything in writing or otherwise at PRI concerning the 'long-arm' proposed interstation device prior to December 1994 - no invention records, no memoranda, no e-mails, no notebooks, no designs, no blueprints, no advertisements and no parts." Declaration of Steve M. Garner, para. 10 (W013383, W013386). In the absence of any written records whatsoever of a conception on July 7, 1994, and unsupported by any corroborative oral testimony of Bird, and absent any corroborative testimony by any witness other than the alleged inventors, DeMoore's alleged statements to his attorney on July 7, 1994 in a meeting are insufficient and are not properly corroborated. *Schwartz, id.*

10. Beyond the meeting of July 7, 1994, DeMoore does not indicate any evidence of possible inventive activity concerning the method until drawings on the part of Rendleman in November - December 1994. A review of the contemporaneous writing portion of the November 1994 - February 1995 drawings, page by page, do not evidence a conception of the method. Several



alternative *structures* are shown at the end-of-press and some are marked as "interstation" devices, but disclosures of devices even labeled "interstation" (Note several drawings PRI 006, PRI 001143, PRI 001144) do not in and of themselves constitute a legally competent complete conception of a method invention. No indication is made on the drawings of why the artisan would want to go "up front" in a lithographic press with a retractable device. The reference to a "rubber anilox" roller on those drawings is not enabling, for the reasons below. Those drawings, at best, are only indicia that the artisan involved may have been considering an apparatus which would perform some method, not of the method itself. More importantly, the particular *method* claimed in the '363 patent is not revealed in the drawings themselves. The drawings do not tell one of ordinary skill in the art the problem to be solved, let alone the advantages of an "interstation" device to solve such a problem. The drawings do not tell the artisan "how to use" the invention, which §112, first paragraph requires. *In re Gardner*, 57 CCPA 1207, 427 F.2d 786, 789, 166 USPQ 138 (CCPA 1970). Concrete statements of utility and purpose are required for a conception or constructive reduction to practice. *Standard Oil Co. (Ind.) V. Montedison S.p.A.*, 494 F. Supp. 370, 385, 206 USPQ 676, 207 USPQ 298 (D. Del. 1980), *aff'd*, 664 F.2d 356, 212 USPQ 327 (3d Cir. 1981); *duPont v. Phillips Petroleum*, 656 F.Supp. 1343, 2 USPQ2d 1545, 1552 (D. Del. 1987), *aff'd in part, rev'd in part*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir 1988).<sup>2</sup> The technical expert reports of both Prince and Taylor

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<sup>2</sup> Appreciation is part of each of the patent law's legal concepts of conception and reduction to practice. *Tilghman v. Proctor*, 102 U.S. (12 Otto) 707, 711-712 26 L.Ed. 279 (1881); *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 43 S.Ct. 322, 67 L.Ed. 523 (1923); *Heard v. Burton*, 51 CCPA 1502, 333 F.2d 239, 142 USPQ 97 (CCPA 1964); *Jennings v. Hill*, 38 CCPA 701, 184 F.2d 187, 87 USPQ 93 (CCPA 1950). The invention must be described sufficiently to impart to a person with ordinary skill and knowledge of the prior art the information needed to devise the invention without further genuine inspiration or undue experimentation. *Seymour v. Osborne*, 78 US (11 Wall) 516, 29 L.Ed. 33 (1871); *In re LeGrice*, 49 CCPA 1124, 301 F.2d 929, 933-934, 133 USPQ 365 (CCPA 1962).

conclude that the drawings in the period from November 1994 to February 1995, taken alone, are not evidence of a teaching of a method. See Taylor report, ¶47, answer to question (c); Prince report, ¶8, answer to question (d).

11. DeMoore and PRI are, therefore, left with their patent application filed on May 4, 1995, Serial No. 08/435,798, as possible evidence of their conception of the '363 method and possibly a constructive reduction to practice. However, the patent application is similarly defective: it does not incorporate by reference the earlier WIMS '976 patent concerning the application of integrated metallic inks, nor any other writing which would give one of ordinary skill the motivation to go "up front" with a flexographic step. Both experts Prince and Taylor are highly critical of Serial No. 08/435,798 for that reason. Taylor report, ¶47, answer to question (d); Prince report, ¶8, answer to question (e). It is well settled that an application, for constructive reduction to practice, must disclose *specific purposes* for which the invention may be used; this requirement may be met either by including utility statements within the application or by introducing evidence that reported properties of the invention were sufficient to justify the conclusion that the material was used for specific purposes. *Standard Oil, Id.* Importantly, Serial No. 08/435,798 did not incorporate by reference the important '976 WIMS patent, which was the basis for the very process improvement of the '363 patent. The application discloses a "double bump" concept whereby the user could allegedly use "interchangeably anilox" or "resilient anilox" rollers at the plate or blanket cylinders to accomplish coating or printing. Expert Taylor indicates that such purported "interchangeability" of printing or coating at the plate or blanket cylinders was in 1995, and is today, illusory. Taylor report, ¶¶47 and 55. Furthermore, expert Taylor indicates that there is no operable support for the

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term "resilient" on page 12 of Serial No. 08/435,798. *Id.* Such an opinion was shared by examiner Fisher in the first Office Action which occurred in Serial No. 08/538,422, leading to U.S. Patent No. 5,960,713, claiming the benefit of the filing date of Serial No. 08/435,798 in a "continuation-in-part" application in August 1998. In my opinion, because it did not incorporate the '976 patent or any other possible parallel teaching, Serial No. 08/435,798 failed in that aspect of 35 U.S.C. §112, first paragraph, in that it did not sufficiently disclose *how to use* the '363 claimed method invention. *Gardner, supra.* Serial No. 08/538,422 was subject to a 35 U.S.C. §112, first paragraph *final rejection*, and DeMoore chose to refile his application and insert new matter (in what became part of column 16 of the '713 patent) as a continuation-in-part, rather than to continue to traverse such a §112, first paragraph rejection and appeal the §112, first paragraph rejection to the Board of Patent Appeals and Interferences. Such a "roll-over" by continuation-in-part without appeal worked an acquiescence on the part of DeMoore; DeMoore and PRI are estopped to deny the lack of enablement of the term "resilient anilox roller." *Pennwalt v. Akzona, Inc.*, 570 F. Supp. 1097, 1101-1104 (D. Del. 1983), *aff'd* 740 F.2d 1573, 222 USPQ 833 (Fed. Cir. 1984). Simply put, for a multitude of reasons, Serial No. 08/435,798 is not enabling and is not a constructive reduction to practice.

12. I have reviewed the file history of Serial No. 08/435,798 from its filing date in May 1995 to June of this year. The application as filed has only two method claims (24 and 30), neither one of which, in my opinion, is Davis' and Williamson's method. Moreover, all of the originally filed method claims were dropped after a restriction requirement and "without traverse." This is tantamount to an intent not to claim. The fact that Davis' and Williamson's method was not claimed is important, as I believe current law dictates that claiming an invention is a requirement of a

constructive reduction to practice in priority disputes. *See, Hybritech Incorporated v. Monocloned Antibodies*, 802 F.2d 1367, 1376, 23 USPQ 81 (Fed. Cir. 1986), and cases cited therein ("... and, it has long been the law, constructive reduction to practice occurs when a patent application on the claimed invention is filed.")

13. Though not emphasized, Plaintiffs allude to the possibility of a "joint inventorship" on the part of Plaintiffs' employees and Davis and/or Williamson with respect to the '363 patent. However, as the declaration and deposition testimony of all parties indicates, all agree that the companies were not *collaborating* toward the solution of a printing problem at any time in 1994. A joint invention is simply the product of *collaboration* between two or more persons *working [closely] together* to solve a problem commonly addressed. *Fina Oil and Chemical Company v. Ewen*, 123 F.3d 1466, 1473, 43 USPQ2d 1935 (Fed. Cir. 1997). There is no evidence whatsoever of a commonly addressed problem. Furthermore, consistent with the parties' uniform testimony, there is no evidence that the parties actually "worked together." In fact, there is no evidence that they ever corresponded with each other by memoranda or e-mails, or interacted in any matter to try to solve a common problem. Each of Davis and Williamson (Rule 131 Declaration, ¶8 (W013000), and Bird Suppl. Decl. ¶¶3-4 (W013194) testify that Davis and Williamson were instructing Bird as to the method starting in August 1994. Davis testified that the tests conducted at PRI in December 1994 and February 1995 were under his direction alone and that Williamson Printing Corporation ("WPC") provided many of the materials. Bird agreed in his deposition. The tests in February 1995 were similarly under Davis' directions and WPC again provided most, if not all, the materials. Bird agreed with that also. The tests in December 1994 and February 1995 were long after the conception transmitted to Baker on June 12, 1994 and were directed to the implementation of the Davis and

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Williamson method concept at their instruction. *Agawam*. Rendleman only testified about a March 1995 trip to Williamson in order to take measurements to make the device requested by Davis and Williamson. Garner's above-recited testimony, that there were no e-mails, notebooks or memoranda between the parties in 1994, further substantiates my opinion that there cannot be a proper finding of joint inventorship.

14. As indicated above, there was no testimony whatsoever in the Rendleman and DeMoore depositions that at any time either DeMoore or Rendleman ever transmitted information concerning a conception of a method to Davis or Williamson or anyone else at WPC. Absent evidence of derivation on the part of WPC and absent joint inventorship, the remedial provisions of 35 U.S.C. §256 are simply not designed to embrace a straight priority contest initiated in the U.S. Federal Courts between two companies, which would parallel an interference proceeding conducted under the rules in the United States Patent and Trademark Office. *Rawlplug Company v. Hilti Aktiengesellschaft, et al.*, 777 F. Supp. 240, 243 (S.D. NY 1991); *Rival Manufacturing Company v. Dazey Products Company*, 358 F. Supp. 91, 101, 177 USPQ 422 (W.D. MO. 1973). *The patent statutes give the United States Patent and Trademark Office exclusive initial jurisdiction to determine priority by interferences.* 35 U.S.C. §135. Plaintiffs' Original Complaint filed May 20, 1999 and First Amended Original Complaint filed September 11, 2000 both speak in terms of *derivation on the part of WPC* of a method allegedly invented by DeMoore, trademarked as "LITHOFLEX™". However, *the proof is clearly to the contrary and is that DeMoore derived the method from Davis and Williamson in mid-June of 1994.* Both the Complaint and the Amended Complaint indicate that Bird and Garner told WPC about the '363 process. Bird and Garner testify

both in their declarations and in their depositions to the contrary. Rendleman's testimony does not support DeMoore's derivation accusation. Most importantly, DeMoore himself indicates he did not speak to Davis and Williamson.

"Q. My question to you – did I ask you whether you had any discussions with Bill Davis or Jesse Williamson where you disclosed anything about the flexo/litho process to them?

A. **Never talked to them about it.**

Q. At any time?

A. **Any time.**

Q. Okay. And I might have already asked you that, if I had, I'm sorry.

A. **That's all right."**

DeMoore Deposition, p. 199, line 24 - p. 200, line 8. The Mott report indicates that Plaintiffs want to use Ser. No. 08/435,798 as part of a priority fight. Lacking any evidence of derivation or of joint inventorship, Section 256 cannot be used as a mechanism to accomplish the priority goals of DeMoore urged in the Mott expert report.

15. As indicated above, 35 U.S.C. §256 was not intended by Congress for the adjudication of a priority contest. Priority contests are to be undertaken at the first instance only in the Patent and Trademark Office pursuant to an interference. That can occur either by declaration of an examiner, pursuant to 35 U.S.C. §135(a), or by a claim timely copied by an applicant for patent from an issued patent pursuant to 35 U.S.C. §135(b)(1):

"A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless a claim is made prior to one year on the date

on which the patent was granted."

In the present instance, PRI and DeMoore indicate (contrary to former PRI employee and executive, Steve Garner, that he knew in December 1997), that they did not know about the issued '363 patent until December 1998, more than a year after the issuance of the patent. However, 35 U.S.C. §135(b)(1) does not indicate that the one year bar is subject to any such knowledge requirement. On the contrary, it establishes a one-year statute of limitation, *regardless* of actual knowledge of the issued patent on the part of the patent applicant. Hence, an interference or priority contest is barred by 35 U.S.C. §135(b)(1) in this situation regardless of whether Garner is telling the truth (PRI knew in December 1997) or DeMoore is telling the truth (in December 1998) in regard to when PRI actually knew about the '363 patent. 35 U.S.C. §291 is not available to PRI as Ser. No. 08/435,798 has not issued and its pending claims do not claim the same invention as the '363 patent. The case law of §291 indicates that for that section to be applicable, both parties must have "substantially identical" patents, and they must be directed to the "same invention". *Dooley Improvements v. Central Hanover Bank & Trust Co. of New York*, 1533, 41 USPQ 698, 27 F. Supp. 531 (D. Col. 1939); *Richard D. Albert, v. Kevek Corporation*, 741 F.2d 396, 399, 223 USPQ 1 (Fed. Cir. 1984); *Engler v. General Electric Co.*, 144 F.2d 191, 194, 62 USPQ 259; *International Signal Co. v. Vreeland Apparatus Co., Inc., et al*, 278 F. 468, 470-471 (2d Cir. 1921). There is no "doctrine of equivalents" in §291 practice. Even were Ser. No. 08/435,798 to issue, there would still be no 35 U.S.C. §291 jurisdiction. What Plaintiffs have tried to do is pursue, under the guise of 35 U.S.C. §256, a belated *non-derivation* priority action barred under 35 U.S.C. §135(b)(1) for a non-'363 claimed invention, that even were Ser. No. 08/435,798 issued, could not be properly maintained under 35 U.S.C. §291.

16. Had an interference been declared on a timely basis within a year of the grant of the '363 patent (on or before May 20, 1998), it is clear that based on the present testimony of Davis and Williamson, WPC would have won the interference. They could have proved both (1) an early corroborated conception in 1992 of their claimed method invention and (2) derivation on the part of DeMoore and PRI on June 12, 1994 of their conceived and later claimed invention. *Shatterproof* and *Agawam* still would have applied. Neither party could have proved an actual reduction to practice prior to WPC's filing date and constructive reduction. Moreover, PRI's alleged constructive reduction of May 4, 1995 could not survive scrutiny. Davis and Williamson could have attacked successfully PRI's alleged "right to make" any method count(s) for lack of enablement, including failure to teach the artisan the significance of the invention so he will know "how to use" the invention.

17. In both the Original Complaint and the First Amended Original Complaint, Plaintiffs urge breach of contract (Amended Original Complaint, Count V) and misappropriation of trade secrets and breach of confidence (Amended Original Complaint, Count VI). Considering the facts here, both counts are, in my opinion, spurious. DeMoore handed out brochures of the "EZ" interstation at the DRUPA conference in May 1995 before an interstation device had been built. DeMoore and PRI published the contents of Serial No. 08/435,798 by the publication of foreign counterparts such as EP 741 025 (A3) in the fall of 1996. DeMoore thus published whatever alleged trade secrets were in the patent application when he filed his original U.S. application on May 4, 1995, since he intended to file foreign applications which was his and PRI's custom. Moreover, DeMoore and PRI did not own the subject matter of Serial No. 08/435,798 to the extent technology within the preview of Fig. 2 of the '363 patent, as that technology was within Davis' and



Williamson's concept and *were the property of WPC, having been completed because of an arms-length contract between PRI and WPC. Agawam.* In my opinion, the depositions, to date, show no implied obligations of confidentiality on the part of WPC with respect to any work performed by PRI for WPC.

18. Based on the expert witness report of Ray Prince, I understand the following: PRI not only filed a patent application directed to the retractable device made at WPC's instructions for the performance of the Davis/Williamson process, Serial No. 08/435,798 (W014527 - W014579), but filed four applications on October 2, 1995 having identical specifications (except as noted below), but not identical claims. These four applications were filed as Serial Nos. 08/538,274 (leading to U.S. Patent No. 5,598,777); 08/538,123 (leading to U.S. Patent No. 5,651,316); 08/538,422 (leading to U.S. Patent No. 5,960,713); and 08/538,021 (leading to U.S. Patent No. 6,116,158). The early 1997 issued '777 and '316 patents did not attempt to claim the benefit of the cantilevered device application, Serial No. 08/435,798. In the instance of the '713 prosecution, a "preliminary amendment" (concurrent with the filing of a "continuation-in-part" application, Serial No. 09/136,901 on August 19, 1998) claimed the benefit of Ser. No. 08/435,798, and in the instance of the '158 prosecution, at the time PRI's present attorneys took over the prosecution in August 1998.

19. In the prosecution of U.S. Patent No. 5,960,713, in the original application Serial No. 08/538,422 the first office action was on January 9, 1997, rejecting all claims, including claims 3, 25 and 26 under 35 U.S.C. §112, first paragraph (Note W02141 - W002142) as the term "anilox roller having a resilient transfer of service" in those claims was deemed by the examiner as not supported by an enabling disclosure. A 35 U.S.C. §112, first paragraph rejection was made *of the same and additional claims in the final rejection on October 28, 1997.* Rather than traverse the art

and 35 U.S.C. §112, first paragraph rejections, applicants DeMoore, et al. chose instead to file a "continuation-in-part application", inserting matter (which ended up in the '713 patent in Col. 16, lines 17-41 (W015393)) to enable the "resilient anilox roller" limitation in certain claims and also, *claim the benefit of the May 4, 1995 filing date of Serial No. 08/435,798.*

20. I have reviewed the expert report of Ray Prince and the Second Supplemental Declaration he filed in the Patent and Trademark Office whereby Prince compared technically the substance of each and every claim of the '713 patent to the specification of Serial No. 08/435,798, and Prince found that none of the claims were supported by the text of Serial No. 08/435,798. It is clear to me as a patent lawyer from an examination of the claims of the four applications filed on October 2, 1995, that none of those claims are supported by the disclosure of Serial No. 08/435,798; the May 4, 1995 application was directed to an auxiliary, cantilevered device which contacted blanket and/or plate cylinders on the *side opposite the dampener*; the four October 2, 1998 applications were directed to technology whereby one, and preferably both the plate and blanket cylinders were contacted *on the dampener side in dedicated stations*. The figures and the text of the two different applications were different. In my opinion, based on Ray Prince's factual examination, and my knowledge of procedures of the Patent and Trademark Office, the claims under 35 U.S.C. §120 to the filing date of Serial No. 08/435,798 in (1) the prosecution leading to the '713 patent, and (2) the prosecution leading to the '158 patent were improper. See Prince report, ¶8, answer to question (t).

21. Moreover, an examination of the continuation-in-part declaration filed in August of 1998 shows no disclosure to the Patent and Trademark Office, as is required by PTO rules and traditional PTO practice of the *published counterparts* of Serial No. 08/435,798 (such as EP 741,025

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(A3)) or the published counterparts of Serial No. 08/538,422, which occurred in April of 1997, all more than a year before the filing date of Serial No. 09/136,901 leading to the '713 patent. The critical fact is that Serial No. 08/435,798 was under final rejection. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148, 109 S.Ct. 971, 103 L.Ed.2d 118, 9 USPQ2d 1847, 1851 (1969); *Chromalloy American Corporation v. Alloy Surfaces, Co.*, 339 F. Supp. 859, 872-876, 173 USPQ 295 (D. Del. 1972). Such failure to disclose published foreign counterparts of earlier applications in the continuation-in-part chain constitutes a violation of 37 C.F.R. §1.56(a), the "duty of disclosure" and constitutes inequitable conduct on the part of DeMoore. *Chromalloy American Corp. v. Alloy Surface, Inc.*, 55 F.R.D. 406, 410, 175 USPQ 148 (D. Del. 1972). The similarity between the facts in this case involving the '713 patent and *Chromalloy* is striking. It is noted that DeMoore and PRI had just changed counsel in early July 1998 from Sidley & Austin to Locke, Liddell & Sapp, and PRI, DeMoore and Rendleman were in a unique position to know the existence of and the status of foreign counterparts of their pending applications at the time of transfer *and they had a duty to inform counsel of when a continuation-in-part was filed*. Further evidence of failure to comply with the duty of disclosure is seen in the failure to disclose the '363 patent until the issue fee was paid in the '713 prosecution in the spring of 1999, despite the fact that, as PRI '713 counsel admitted in the paper to the PTO, the '363 patent was known to PRI at least as early as December of 1998.

22. Similar disclosure problems exist in the prosecution of U.S. Patent No. 6,082,257 to Secor which has substantially all of its disclosure and figures coming from Serial No. 08/435,798. Applicant Secor at no time disclosed to the Patent Office the fact that the bulk of the disclosure and figures came from Serial No. 08/435,798, and did not disclose the publication of foreign counterparts

to Serial No. 08/435,798, which had been published more than a year prior to his filing date. Ironically, Secor disclosed the second published patent of the four patents commonly based on the October 2, 1995 filing date, but did not disclose the pertinent foreign publication counterparts to Serial No. 08/435,798 directed to the cantilevered device that had the "bumping" problem his device was directed to solve. Secor's application and that of Serial No. 08/435,798 were assigned to different examiners, and the file history of Serial No. 08/435,798 and the '257 patent reflects neither examiner knew about the existence of the other application. The '257 examiner should have been informed about Serial No. 08/435,798 and the fact that a different *inventive entity had allegedly invented same, as well as the foreign counterparts*. Secor also "borrowed" the same insertion pertaining to the supporting enablement for "resilient anilox roller" at Col. 16, lines 17-41 in the prosecution leading to the '713 patent on August 19, 1998. Accordingly, very little of the '257 patent specification and drawings can be possibly attributed to Secor, something that his examiner did not know.

B. R. Pravel  
Bernarr R. Pravel

Date: Nov. 16, 2000

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing Responsive Expert Witness Report of Bernarr Roe Pravel was served on Plaintiffs' counsel by placing a true and correct copy thereof in the United States Mail, postage prepaid, on the 17 day of November, 2000, addressed as follows:

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